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In re Application of  
MIYAJI et al.  
Application No.: 09/763,793  
PCT No.: PCT/JP99/04602  
Int. Filing Date: 26 August 1999  
Priority Date: 27 August 1998  
Attorney's Docket No.: 766.46  
For: NOVEL POLYPEPTIDE

DECISION ON PETITION

UNDER 37 CFR 1.181

This is in response to applicant's 03 December 2003 petition entitled "Petition under 37 CFR 1.137(a)" to withdraw holding of abandonment based on a failure to receive an office action, filed in the United States Patent and Trademark Office (USPTO), which is being treated as a petition under 37 CFR 1.181. Applicant alleges that he did not receive the an Office action mailed on 03 April 2001. Should their argument under 37 CFR 1.181 fail, applicant requests consideration under 37 CFR 1.137(a) or (b).

### **BACKGROUND**

On 27 February 2001, within the thirty month deadline, applicant filed a transmittal letter requesting a filing under 35 U.S.C. 371. A review of the application file reveals that the "NOTIFICATION TO COMPLY WITH REQUIREMENTS FOR PATENT APPLICATIONS CONTAINING NUCLEOTIDE SEQUENCE AND/OR AMINO ACID SEQUENCE DISCLOSURES" was mailed by the USPTO on 03 April 2001. The notification indicated that applicant must provide an initial or substitute computer readable form (CFR) of the 'Sequence Listing'.

On the same date (03 April 2001), a Notification of Abandonment (Form PCT/DO/EO/909) was mailed to applicant, indicating that applicant had failed to provide the full U.S. Basic National Fee by the thirty month period.

### **DISCUSSION**

In order to establish that papers were not received, a petition under 37 CFR 1.181 with a proper showing is required. As set forth in the Official Gazette at 1156 OG 53, the petition must include the following: (1) a statement by the practitioner that the Office action was not received by the practitioner; (2) a statement attesting that a search of the file jacket and docket records indicates that the Office action was not received; and (3) a copy of the docket record where the non-received Office action would have been entered had it been received (the docket records must also be referenced in practitioner's statement). No petition fee is required.

Counsel for applicant states that he did not receive the Office communication mailed on 03 April 2001 and that a search of the file jacket and docket records indicates that the Office action was not received. Counsel also submitted a copy of "the Docket Record for the above

identified application where the nonreceived Office communication would have been entered had it been received and docketed. The Docket Record also shows all replies docketed (here, none) to date for this application..."

Attorney for applicant proffers that the mailing address used by the USPTO on the Notification To Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures and Notification of Abandonment (30 Rockefeller Plaza, New York, NY 10112) was in error since it did not include the name of the law firm and that this is the cause of his nonreceipt of said Notifications. Counsel states that the correct address (Fitzpatrick, Cella, Harper & Scinto, 30 Rockefeller Plaza, New York, NY 10112) is the address listed on the transmittal letter for entry in the U.S. national stage filed on 27 February 2001.

A review of the application file and the USPTO records indicates that counsel listed the "Fitzpatrick, Cella, Harper & Scinto, 30 Rockefeller Plaza, New York, NY 10112" address on the transmittal letter for this application. However, the USPTO PALM record incorrectly lists the incomplete correspondence address.

The Notification of To Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures mailed on 03 April 2001 and Notification of Abandonment mailed on 03 April 2001 is hereby vacated.

Per applicant's 03 December 2003 request, applicant's address will be corrected in the USPTO records to include the name of the law firm "Fitzpatrick, Cella, Harper & Scinto".

A review of the fees for this application reveals the following. Applicant's transmittal letter filed on 27 February 2001 requesting entry into the national stage indicates that a check for \$3,618 was enclosed. A review of the USPTO finance records does not indicate that any fees were paid in connection with this case. However, applicant did authorize that any deficiency be charged to his deposit account and provided the deposit account number. Therefore, the U.S. basic national fee will be charged to the deposit account per applicant's authorization. Thus, the application can not be considered to be abandoned for failure to pay the basic national fee by the thirty month period.

Applicant's petitions to revive under 37 CFR 1.137(a) or in the alternative, 37 CFR 1.137(b) are considered moot.

The itemized postcard receipt dated 27 February 2001 does not indicate that an oath or declaration was received with the initial filing. Hence, a Notification of Missing Requirements will be issued indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b), and the \$130 surcharge for filing the oath or declaration after the thirty month period are required.

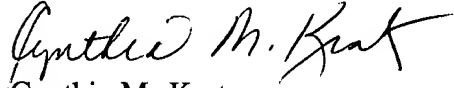
### CONCLUSION

For the reasons presented above, the Petition to withdraw the holding of abandonment under 37 CFR 1.181 is **GRANTED**.

The Notification to Comply with Requirements for Patent Applications Containing Nucleotide Sequence and/or Amino Acid Sequence Disclosures and the Notification of Abandonment (Form PCT/DO/EO/909) mailed on 03 April 2001 are hereby **VACATED**.

Applicants' correspondence address will be corrected in the USPTO records to include the name of the law firm "Fitzpatrick, Cella, Harper & Scinto".

The application will be forwarded to the United States Designated/Elected Office for further processing, including issuance of the Notification of Missing Requirements indicating that an oath or declaration, in compliance with 37 CFR 1.497(a) and (b), and the \$130 surcharge for filing the oath or declaration after the thirty month period is required.



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